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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/542,538	01/20/2006	Peter Wirth	OST-051180	7043
22876 7590 01/18/2008 FACTOR & LAKE, LTD 1327 W. WASHINGTON BLVD. SUITE 5G/H CHICAGO, IL 60607				
EXAMINER				
BARRY, ERIN P				
ART UNIT		PAPER NUMBER		
4111				
MAIL DATE		DELIVERY MODE		
01/18/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/542,538

Applicant(s)

WIRTH, PETER

Examiner

ERIN P. BARRY

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2006.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
4a) Of the above claim(s) 6-9, 17-24, 34-35, 40-47 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1, 2, 4, 10-13, 15, 16, 25-30, 32, 36 and 38 is/are rejected.
7) ☒ Claim(s) 3, 5, 14, 16, 31, 33, 37 and 39 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 11/2/2005
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

Species I has the special technical feature of a device for adjusting the workpiece in the direction of the axis of the through opening of the portal

Species II has the special technical feature of a device for adjusting the cutting or welding torch in the direction of the axis of the through opening of the portal

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

2. The claims are deemed to correspond to the species listed above in the following manner:

Species I: claim 4
Species II: claim 6

The following claim(s) are generic: 1,2, and 13.

3. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: Species I has the special technical feature of a device for adjusting the workpiece in the direction of the axis of the through opening of the portal and species II has the special technical feature of a device for adjusting the cutting or welding torch in the direction of the axis of the through opening of the portal.

4. During a telephone conversation with Joseph Kinsella on 12/12/2007 a provisional election was made without traverse to prosecute the invention of figures 1-3, claims 1-5, 10-16, 25-33 and 36-39. Affirmation of this election must be made by applicant in replying to this Office action. Claims 6-9, 17-24, 34-35, and 40-47 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 4-5 and 15-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 4-5 and 15-16 are indefinite, because it is unclear which "device" is referred to in this claim since there is mention of two different devices within the claims. It is unclear whether the device recited in the claims are referring to the "guiding device" or "a device by which relative movement between the workpiece and the cutting of welding torch in the axial direction of the through opening can be brought about". For the purpose of examination, a 1st "device" and a 2nd device recited in these claims are assumed to be referring to the guiding device and a device acting on the relative movement of the workpiece and the cutting of the welding torch, respectively.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-2, 4, 10, 13, 15, 25, 28, 32, 36, and 38 are rejected under 35 U.S.C. 102(b) as being anticipated by Ricci (5,685,996).

Regarding claims 1 and 4, Ricci has a guiding device for a cutting device where the device is controlled so the cutting follows a predetermined line because torch is affixed to a ring 84 and travels along the ring at a predetermined angle in excess of 360 degrees (column 5 lines 62-67). There is a portal where the workpiece can be guided in an axial direction using a conveyor (column 5 lines 1-6). Ricci states a movable ring 84 that is rotatable about the axis of the through opening with a motor (column 3 line 63 to column 4 line 2). There is a holding arm where the free end 102 carries the cutting torch 104 and the other end 114 is fixed to the rotary part 100 (figure 3). The cutting torch can be adjusted radially in relation to the axis of the through opening by loosening the U-shaped torch holder 140. The cutting torch can also be brought into different angular positions in relation to the surface of the workpiece by loosening the thumb screw 142 and allowing the torch 102 to be tipped at an angle with respect to the vertical in a range of 0-38 degrees (column 4 lines 55-64 and figure 3). The conveyor is used to create relative movement between the workpiece and cutting torch in the axial direction through the opening (column 5 lines 1-6).

Regarding claim 2, Ricci has a rotary part 84 in the shape of a ring rotatable through about the opening arranged on one end of the face 116 of the portal which is mounted in a guide 100 (figures 1 and 3).

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Regarding claims 10, 25 and 32, 36, and 38 Ricci shows seven threaded elongated clamps around the ring. These clamps act as guides as they help position and prevent the workpiece from moving (figure 2).

Regarding claims 13 and 28, Ricci states that the position of the through opening is adjustable in the vertical direction by the hydraulic jack 72 (figure 2 and column 5 lines 7-12).

Regarding claim 15, Ricci states that the conveyor brings the workpiece to be cut into pieces to the ring assembly (column 5 lines 1-6).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 11, 26, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ricci (5,685,996) as applied to claims 10 and 25 above, and further in view of Mahony (3,194,611).

Regarding claims 11 and 26 Ricci does not have guide rollers as the guide to move the work piece in the portal. However, Mahony does have guide rollers 24 to move a work piece (pipe) P through a portal 10 (figure 2). It would have been obvious at the time of the invention to use guide rollers to move the work piece in a portal to be welded because it cuts down on time and manual labor of having to use pins or clamps

to be able to move the work piece into place and then adjust the pins or clamps to hold the work piece in place.

Regarding claim 29, Ricci states that the position of the through opening is adjustable in the vertical direction by the hydraulic jack 72 (figure 2 and column 5 lines 7-12).

11. Claims 12, 27, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ricci (5,685,996) and Mahony (3,194,611) as applied to claim 11 and 26 above, and further in view of Pease (5,524,813).

Regarding claims 12 and 27, neither Ricci nor Mahony teaches a motor to move the guide rollers. However, Pease does have a drive means on rollers (drive cylinders) 40 that linearly advance the work piece (column 3 lines 30-30 and figure 1). It would have been obvious at the time of the invention to use a driving means to move the workpiece into the portal because it cuts back on time and manual labor by automatically advancing the workpiece.

Regarding claim 30, Ricci states that the position of the through opening is adjustable in the vertical direction by the hydraulic jack 72 (figure 2 and column 5 lines 7-12).

Allowable Subject Matter

12. Claims 3, 5, 14, 16, 31, 33, 37, and 39 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Regarding claims 3 and 14, no prior art was found that had a holding arm comprising of three sections where each section as stated in the claims is movable by a motor as recited in claims 3 and 14 as a whole . Regarding claim 5, no prior art was found to include a carry-along slide that is movable parallel to the axis of the through opening and can be brought into carry-along connection with the work piece.

Claims 16, 31, 33, 37, and 39 are allowable because of dependence to claims 3, 5 or 14.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ERIN P. BARRY whose telephone number is (571)270-3634. The examiner can normally be reached on Monday through Thursday from 8am-5pm Eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sam Yao can be reached on (571) 272-1224. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

EPB

1/15/2007

/Sam Chuan C. Yao/

Supervisory Patent Examiner, Art Unit 4111